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REMARKS

Claims 27-29 were rejected in an Office Action dated April 20, 2006. Claims 27 and 29 have been amended for purposes of clarity only, and claims 30-43 have been added. Support for the new claims may be found generally in the "Detailed Description of the Invention", the Figures and the Example. Applicants respectfully request reconsideration of the present application in view of the following remarks.

Rejections under 35 USC §103

Claims 27 and 29 have been amended to correct for clarity and antecedent basis, not for the purpose of patentability in view of Garbuio. Claims 27-29 were rejected under 35 USC §103(a) as being unpatentable over Garbuio (US Patent No. 3,925,916). Applicant traverses the rejection.

Applicant asserts that independent claim 27 is patentable over Garbuio where Garbuio does not disclose or suggest a method of insulating a boot comprising, among other things, providing an insulating component comprising an insulating structure having a thermal conductivity less than or equal to air. Applicant traverses the statement of the Office that, since Garbuio has the same utility as applicant's claimed invention, Garbuio must necessarily have a thermal conductivity less than or equal to 25 mW/m K at 25°C. Such facts are unsupported by the teachings of Garbuio and this reasoning would seem to be based on hindsight reconstruction in view of the teachings of the instant invention.

Applicant asserts that one skilled in the art of foamed materials would understand that the core material as discussed in Garbuio would have a thermal conductivity of greater than air, as do conventional insulating materials for apparel (see Background section of the instant application). The core material taught by Garbuio has as its constituents, air and open-celled foam (which is made of air and foamed material). Where one skilled in the art knows that the thermal conductivity of air is about 25 mW/m K at about 25°C, and the thermal conductivity of plastic material from which the open-celled foam is made (e.g., polyurethane) is greater than air at ambient conditions, one skilled in the art would understand the liner of Garbuio to have a thermal conductivity greater than air, or greater than 25 mW/m K at about 25°C.

Garbuio teaches forming the liner by sealing the envelope along the boundary with very little effort and conventional equipment (col.2, lines 50-55). Thus, no method is disclosed or suggested for forming a liner having a lower

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thermally conductive liner than which would be expected to be formed from the materials provided and conventional equipment. Therefore, where neither the materials nor the method taught by Garbuio disclose or suggest a liner having a thermal conductivity less than or equal to air, the method of independent claim 27 is neither disclosed nor suggested by Garbuio; removal of the rejection under 35 USC §103(a) is respectfully requested.

With regard to the dependent claims 28 and 29, Garbuio does not disclose or suggest positioning a foot-fitting liner between inner or outer boot layers or affixing the liner to an inner boot layer. Moreover, to do so would make the liner of Garbuio unfit for its intended purpose of providing an extractable liner for a ski boot which can also be worn on the foot outside the boot (col. 2, lines 48-49). Thus, removal of the rejection to claims 28 and 29, and an indication of allowable subject matter, is respectfully requested.

New claims 30-43 are deemed allowable for the reasons given above for independent claim 27, and where Garbuio does not disclose or suggest the claimed substantially incompressible insulating structure. The structure of Garbuio is necessarily resilient and elastomeric to provide effective cushioning from lateral pressure without materially impeding mobility (col. 2, lines 29-48), thus, new claim 30, and the claims dependent thereon, are novel and non-obvious.

New claims 33-35 directed to fumed metal oxide porous material are not disclosed or suggested by the elastomeric, open-celled porous foam material of Garbuio which is selected for e.g. resiliency.

New claims 36-41 are directed, in part, to the method of evacuating the gas impermeable envelope to a reduced pressure. This claimed feature is not disclosed or suggested by Garbuio. Where Garbuio teaches a foot-fitting liner having an elastomeric core wherein "the core [which] has a multiplicity of interstices filled with air", the instantly claimed invention is neither disclosed nor suggested. Moreover, to evacuate Garbuio of air would render it unfit for its intended purpose of providing a resilient and cushioning liner. Thus, where Garbuio provides no motivation or incentive to evacuate air from the foot-fitting liner and where it would be understood by one skilled in the art that the method of evacuating air from the liner would render Garbuio unfit for its intended purpose, the instantly claimed invention is patentably distinct.

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Double Patenting

Claims 27-29 were provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-34 of copending Application No. 11/106,788 in view of Garbuio (US Patent No. 3,925,916). Applicant asserts that, as pointed out in the Office Action, not every feature of the claims of the instant application is claimed in copending Application No. 11/106,788. The combination of features is not disclosed or suggested by Garbuio, and are therefore not obvious. Garbuio, directed to a foot-fitting insert for filling up the internal clearance in an integrally molded ski boot by providing a resilient, elastomeric core having interstices filled with air, does not address a method for making an insulated article of apparel comprising an insulating structure with a thermal conductivity less than or equal to air. There is no incentive to modify the copending application by the teachings of Garbuio absent hindsight reconstruction based on the instantly claimed invention. Removal of the rejection is therefore requested. In the event the rejection of Double Patenting is maintained, Applicant will consider filing a terminal disclaimer after final disposition of the claims.

Conclusion

For the foregoing reasons, the present invention as defined by claims 27-43 is neither taught nor suggested by any of the references of record. Accordingly, Applicant respectfully submits that these claims are now in form for allowance. If further questions remain, Applicant requests that the Examiner telephone Applicant's undersigned representative before issuing a further Office Action.

Respectfully submitted,



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